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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,772	11/02/2001	Toshio Ueno	01706/LH	4311
1933	7590	08/30/2004	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC			ZURITA, JAMES H	
767 THIRD AVENUE			ART UNIT	PAPER NUMBER
25TH FLOOR				3625
NEW YORK, NY 10017-2023				

DATE MAILED: 08/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/002,772	UENO, TOSHIO <i>cp</i>	
	<b>Examiner</b>	<b>Art Unit</b>	
	James H Zurita	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 02 November 2001.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-33 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-33 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>multiple</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Objections***

The following claims are objected to because of the following informalities:

Regarding claims 22-26, use of the phrase "means for" appears to be an attempt to invoke 35 U.S.C. 112, sixth paragraph, to recite claim element(s) as a means for performing a specified function. However, since the disclosures provide no structural support for the claims, it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to

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promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In this case, Claims 1-21 and 31-32 have no connection to the technological arts. None of the steps indicate any connection to a computer or technology. The step of communicating over a network could be performed manually by a person physically delivering the information to a "network" of chain stores within an area. The term "network" could also include sending the information through the US Postal network, using a courier service such as UPS to deliver the information through its network of carriers, etc.. Therefore, the claims are directed towards non-statutory subject matter. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological arts, such as incorporating a computer network or electronic network into the communicating steps; for example: "(a) communicating over a computer network..." Calculations such as in claims 3, 14 and 24 can be performed using an abacus or paper and pencil.

Claims 22-30 and 33, drawn to medium and program code fail to recite **computer executable** instructions. The claims are directed to **computer-readable** program code. Giving the term its broadest reasonable interpretation, the claims are directed to source code, text, a program per-se and a program listing. Accordingly, these claims fail to recite a positive functional interrelationship between the medium and the activities recited. Please refer to MPEP 2106.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Squeglia et al. (US PG-PUB 2002/0156692 A1).

**As per claims 1, 12 and 22,** Squeglia discloses methods, systems and computer-executable instructions for coping changes in hardware including:

- **accessing** a product of (a railcar, for example) a user through a network and acquiring information on the product of the user. See, for example, at least paragraph 23 and Fig. 1.
- **acquiring** information on a part to be changed. See, for example, at least paragraph 24 and other references to parts such as locomotive systems, subsystems, assemblies.
- **generating** information on a product that requires change of a part, from the information on the product of the user and the information on the part to be changed. See, for example, at least paragraph 25, 26 and 28. See also other references to repair recommendations.

**As per claims 2, 13 and 23,** Squeglia discloses notifying the information on the product that requires change of the part to an equipment owned by a person in charge

of service. See, for example, at least Paragraph 2, and Fig. 1, for references to service shop(s) on a network.

***As per claims 3, 14 and 24,*** Squeglia discloses calculating a number of parts to be changed based on the information on the product that requires change of the part. See, for example, at least paragraph 35 and references to calculating parts based on information such as repair actions, fault codes, and others.

***As per claims 4, 15 and 25,*** Squeglia discloses generating order data on the part to be changed from the calculated number of parts to be changed. See, for example, at least paragraph 39 concerning generating maintenance and repair work orders.

***As per claims 5, 16 and 26,*** Squeglia discloses transmitting the order data to a service parts system. See, for example, at least Paragraph 2, Fig. 1 and other related text for references to Parts requisition centers, MDSC Monitoring and Diagnostic Service Center. These systems are inter-connected and order data is communicated.

***As per claims 6, 17 and 27,*** Squeglia discloses that acquired information on the part to be changed includes solution information, and the solution information is notified to the equipment owned by the person in charge of service along with the information on the product that requires change of the part. See, for example, at least paragraph 26 and references to problem resolution suggestions and repair actions.

***As per claims 7, 18 and 28,*** Squeglia discloses that information on the product of the user includes a product manufacture number. See, for example, references to

equipment information by model number. Locomotives are sold by particular model numbers. See also references to locomotive identification number.

**As per claims 8 and 19,** Squeglia discloses that information on the product of the user includes information on an option configuration. See, for example, at least paragraphs 6 -9.

**As per claim 9,** Squeglia discloses that information on the product of the user includes information on a network configuration. See, for example, at least paragraph 9, concerning networks. See also paragraph 23 concerning types of links to a network. Such information allows a user to connect in various ways to networks. See also references to wireless networks, paragraph 54.

**As per claims 10, 21 and 29,** Squeglia discloses that information on the product of the user includes usage condition information. See, for example, references to condition-based maintenance, paragraph 2 and others.

**As per claims 11, 20 and 30,** Squeglia discloses that information on the product of the user includes software information. See, for example, at least paragraph 40 concerning software version configuration.

**As per claims 31-33,** Squeglia discloses that software information is software version information. See, for example, at least paragraph 40 concerning software version configuration.

As per claims 1-33, Squeglia **does not** specifically refer to a product information acquiring section, a change information acquiring section, an information generating

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*section* (claim 12); a notifying *section* (claim 13) a calculating *section* (claim 14); an order data generating *section* (claim 15) a transmitting *section* (claim 18).

However, the labels given to various actors and modules are not functionally related to the substrate of the article of manufacture. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a label to various actors and modules in a system such as Squeglia because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious.

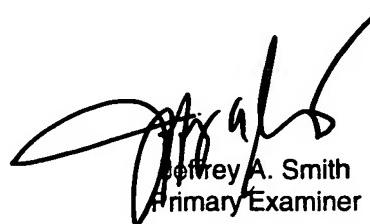
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Zurita  
Patent Examiner  
Art Unit 3625  
17 August 2004



Jeffrey A. Smith  
Primary Examiner